MARK D. SELWYN (CA SBN 244180)
mark.selwyn@wilmerhale.com
WILMER CUTLER PICKERING
HALE AND DORR LLP
2600 El Camino Real, Suite 400
Palo Alto, California 94306
Telephone: (650) 858-6000
Facsimile: (650) 858-6100

CATHERINE M.A. CARROLL (*pro hac vice*)
catherine.carroll@wilmerhale.com
WILMER CUTLER PICKERING
HALE AND DORR LLP
1875 Pennsylvania Avenue NW
Washington, DC 20006
Telephone: (202) 663-6000
Facsimile: (202) 663-6363

Attorneys for Plaintiffs Apple Inc., Cisco Systems, Inc., and Intel Corporation

DANIEL T. SHVODIAN (CA SBN 184576)
DShvodian@perkinscoie.com
PERKINS COIE LLP
3150 Porter Drive
Palo Alto, CA 94304
Telephone: (650) 838-4300
Facsimile: (650) 737-5461

Attorney for Plaintiff Google LLC

JOHN B. SGANGA (CA SBN 116211)
John.Sganga@knobbe.com
KNOBBE MARTENS OLSON & BEAR
LLP
2040 Main Street, 14th Floor
Irvine, CA 92614
Telephone: (949) 760-0404
Facsimile: (949) 760-9502

Attorney for Plaintiffs Edwards Lifesciences Corporation and Edwards Lifesciences LLC

A complete list of parties and counsel appears on the signature page per Local Rule 3-4(a)(1)

UNITED STATES DISTRICT COURT

FOR THE NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

APPLE INC., CISCO SYSTEMS, INC., GOOGLE LLC, INTEL CORPORATION, EDWARDS LIFESCIENCES CORPORATION, and EDWARDS LIFESCIENCES LLC,

Plaintiffs,

v.

ANDREI IANCU, in his official capacity as Under Secretary of Commerce for Intellectual Property and Director, United States Patent and Trademark Office,

Defendant.

Case No. 20-cv-6128-EJD

PLAINTIFFS' RESPONSE TO DEFENDANT'S NOTICE OF SUPPLEMENTAL AUTHORITY

Date: Under Submission

Judge: Hon. Edward J. Davila

After this Court denied the motions of US Inventor and others to intervene and for a preliminary injunction in this case, ECF No. 101 (Feb. 5, 2021), they filed a complaint in the U.S. District Court for the Eastern District of Texas asserting the same claims and seeking the same relief they had sought to pursue here: that the Patent and Trademark Office ("PTO") was required to conduct a notice-and-comment rulemaking to adopt a regulation setting forth comprehensive standards for showing "sufficient grounds" to institute inter partes review ("IPR"), that the court should compel such a rulemaking, and that the court should prohibit the PTO from instituting IPR until such regulation has issued. *See US Inventor Inc. v. Hirshfeld*, No. 2:21-cv-00047-JRG, slip op. 4-5 (July 13, 2021), ECF No. 29. The decision dismissing that case for lack of standing does not aid the Director here.

In its notice to this Court, the government notes (at 2) that the *US Inventor* court stated: "The decision not to institute an [IPR] trial does not affect any substantive rights." *US Inventor*, slip op. 7. That has no bearing here because, critically, the court was addressing only the rights of patent owners, not of IPR petitioners seeking to challenge a patent. *See id.* at 7-8. The question of whether the denial of an IPR petition affects *the petitioner's* rights was not present. As this Court recognized, US Inventor and other proposed intervenors—now among the plaintiffs in *US Inventor*—"do not have a significant protectable interest related to the Plaintiffs' claims" here. Order Denying Motion to Intervene and Motion for Entry of a Preliminary Injunction 9, ECF No. 101.

The *US Inventor* court also observed: "In general, as the Supreme Court and the Federal Circuit have stated, patent challengers and patentees at the [Patent Trial and Appeal Board] have no right either to institution or to denial of institution." *US Inventor*, slip op. 7-8. But that, too, is irrelevant here because Plaintiffs do not contend that they have a "right … to institution." Rather, Plaintiffs contend that the *NHK-Fintiv* rule unlawfully restricts or removes their opportunity to have a patent canceled through the more efficient mechanism of IPR, and that their IPR petitions should be considered without application of that rule. *See* Plaintiffs' Memorandum in Opposition to Defendant's Motion to Dismiss the Amended Complaint ("MTD Opp.") 9-10, ECF No. 92; Plaintiffs' Reply in Support of Their Motion for Summary Judgment ("MSJ Reply") 14, ECF No. 96.

Finally, the *US Inventor* court reiterated the Supreme Court's passing remark that the decision

to deny an IPR petition is "'committed to the Patent Office's discretion.'" *US Inventor*, slip op. 3, 8 (quoting *Cuozzo Speed Technologies, LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016)). But that reiteration does not give the Supreme Court's remark relevance that it previously lacked. As Plaintiffs have explained, Plaintiffs do not challenge here any particular denial decision; they challenge a rule that the Director adopted to govern all cases. Moreover, the Supreme Court has made clear that whatever institution discretion the PTO has is bounded by the America Invents Act and the Administrative Procedure Act, and that the courts are available to decide claims that the PTO's exercise of discretion exceeded those statutory boundaries. *See* MTD Opp. 20-25; MSJ Reply 4-5; Plaintiffs' Motion for Summary Judgment 15-16, ECF No. 65. The court in *US Inventor* had no occasion to address that issue, and nothing in its opinion suggests otherwise.

Dated: July 19, 2021

Respectfully submitted,

By: */s/ Mark D. Selwyn*

MARK D. SELWYN (CA SBN 244180)
mark.selwyn@wilmerhale.com
WILMER CUTLER PICKERING
HALE AND DORR LLP
2600 El Camino Real, Suite 400
Palo Alto, California 94306
Telephone: (650) 858-6000
Facsimile: (650) 858-6100

CATHERINE M.A. CARROLL (*pro hac vice*)
DAVID M. LEHN (*pro hac vice*)
catherine.carroll@wilmerhale.com
david.lehn@wilmerhale.com
WILMER CUTLER PICKERING
HALE AND DORR LLP
1875 Pennsylvania Avenue NW
Washington, DC 20006
Telephone: (202) 663-6000
Facsimile: (202) 663-6363

ALYSON ZUREICK (*pro hac vice*)
alyson.zureick@wilmerhale.com
WILMER CUTLER PICKERING
HALE AND DORR LLP
7 World Trade Center

250 Greenwich Street
New York, NY 10007
Telephone: (212) 230-8800
Facsimile: (212) 230-8888

Attorneys for Plaintiffs Apple Inc., Cisco Systems, Inc., and Intel Corporation

DANIEL T. SHVODIAN (CA SBN 184576)
DShvodian@perkinscoie.com
PERKINS COIE LLP
3150 Porter Drive
Palo Alto, CA 94304
Telephone: (650) 838-4300
Facsimile: (650) 737-5461

THERESA NGUYEN (CA SBN 284581)
RNguyen@perkinscoie.com
PERKINS COIE LLP
1201 Third Avenue, Suite 4900
Seattle, WA 98101
Telephone: (206) 359-6068
Facsimile: (206) 359-9000

ANDREW T. DUFRESNE (*pro hac vice*)
ADufresne@perkinscoie.com
PERKINS COIE LLP
33 East Main Street, Suite 201
Madison, WI 53703
Telephone: (608) 663-7492
Facsimile: (608) 663-7499

Attorneys for Plaintiff Google LLC

JOHN B. SGANGA (CA SBN 116211)
CHRISTY G. LEA (CA SBN 212060)
John.Sganga@knobbe.com
Christy.Lea@knobbe.com
KNOBBE MARTENS OLSON & BEAR LLP
2040 Main Street, 14th Floor
Irvine, CA 92614
Telephone: (949) 760-0404
Facsimile: (949) 760-9502

Attorneys for Plaintiff Edwards Lifesciences Corporation and Edwards Lifesciences LLC

ATTORNEY ATTESTATION

I, Mark D. Selwyn, am the ECF User whose ID and password are being used to file this document. In compliance with N.D. Cal. Civil L.R. 5-1(i)(3), I hereby attest that concurrence in the filing of the document has been obtained from each of the other signatories.

By: /s/ *Mark D. Selwyn*
Mark D. Selwyn

CERTIFICATE OF SERVICE

I hereby certify that on July 19, 2021, I electronically filed the above document with the Clerk of the Court using CM/ECF which will send electronic notification of such filing to all registered counsel.

By: /s/ *Mark D. Selwyn*
Mark D. Selwyn